

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Mimi C. DONG

Confirmation No.: 9404

Application No.: 09/863,560

Examiner: Le, Brian Q.

Filing Date: May 23, 2001

Group Art Unit: 2623

Title: FINGERPRINT ADDRESSING SYSTEM AND METHOD

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on May 19, 2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

() one month	\$120.00
() two months	\$450.00
() three months	\$1020.00
() four months	\$1590.00

() The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account **08-2025** the sum of \$500.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

Mimi C. DONG

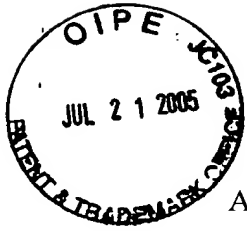
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES

Applicant: Mimi C. Dong Confirmation No. 9404
Application No.: 09/863,560
Filed: May 23, 2001
Art Unit: 2623
Examiner: Le, Brian Q.
Docket No.: 10010208-1
Title: Fingerprint Addressing System and Method

MAIL STOP: APPEAL BRIEF PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Dear Sir:

APPEAL BRIEF

Applicant has appealed to the Board of Patent Appeals and Interferences from the decision of the Examiner mailed April 12, 2005, finally rejecting Claims 1-19. Applicant filed a Notice of Appeal on May 19, 2005. Applicant respectfully submits herewith this Appeal Brief with authorization to charge the statutory fee of \$500.00.

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REAL PARTY IN INTEREST

The present application was assigned to Hewlett-Packard Company as indicated by an assignment from the inventor recorded on September 24, 2001, in the Assignment Records of the United States Patent and Trademark Office at reel 012197, frame 0098. The present application was subsequently assigned to Hewlett-Packard Development Company, L.P. as indicated by an assignment from Hewlett-Packard Company recorded on September 30, 2003, in the Assignment Records of the United States Patent and Trademark Office at reel 014061, frame 0492.

RELATED APPEALS AND INTERFERENCES

There are no known appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATUS OF CLAIMS

Claims 1-19 stand rejected pursuant to a Final Office Action mailed April 12, 2005. Claims 1-19 are presented for appeal.

STATUS OF AMENDMENTS

No amendment has been filed subsequent to the mailing of the Final Office Action.

SUMMARY OF INVENTION

Independent Claim 1

Embodiments of the present invention as defined by independent Claim 1 are directed toward a device (24, 50, 80) comprising connection to a network (22, 45, 74) and a network address derived from a user's fingerprint (at least at page 3, lines 1-31, page 4, lines 3-16 and 17-31, page 5, lines 3-21, figures 1-3).

Independent Claim 6

Embodiments of the present invention as defined by independent Claim 6 are directed toward a system (10) comprising a connection to a network (22, 45, 74) and a

network address derived from a fingerprint of a user (at least at page 3, lines 1-31, page 4, lines 3-16 and 17-31, page 5, lines 3-21, figures 1-3).

Independent Claim 14

Embodiments of the present invention as defined by independent Claim 14 are directed toward a method comprising generating a network address derived from a user's fingerprint and accessing a system over a network using the derived network address (at least at page 3, lines 1-31, page 4, lines 3-16 and 17-31, page 5, lines 3-21, figures 1-3).

GROUND OF REJECTION

1. Claims 1-19 are rejected under 35 U.S.C. §103(a) as being unpatentable in view of U.S. Patent No. 6,738,053 issued to Borgstrom (hereinafter "*Borgstrom*").

ARGUMENT

A. Standard

1. 35 U.S.C. § 103

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991); M.P.E.P. § 2143. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.* Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Additionally, not only must there be a suggestion to combine the functional or operational aspects of the combined references, but also the prior art is required to suggest both the combination of elements and the structure

resulting from the combination. *Stiftung v. Renishw PLC*, 945 F.2d 1173, 1183 (Fed. Cir. 1991). Moreover, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 (Fed. Cir. 2000). "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion or incentive supporting the combination." *See In re Geiger*, 815 F.2d 686, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987). Further, when the incentive to modify or combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why such combination or modification is proper, and absent such reasons or incentives, the teachings of the references are not combinable or modifiable. *See Ex parte Skinner*, 2 USPQ 2d 1788, 1790 (B.P.A.I. 1987).

B. Argument

Claims 1-19 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Borgstrom*. Of the rejected claims, Claims 1, 6 and 14 are independent. Applicant respectfully submits that each independent claim is patentable over the cited reference, and thus remaining Claims 2-5, 7-13 and 15-19 which depend respectively from the independent claims are also patentable.

Embodiments of the present invention generally involve a fingerprint-based network addressing system (10) having a device (e.g., a mobile controller 24 and/or mobile device 50, 80) adapted to generate a network, or an Internet Protocol (IP), address (at least at page 3, lines 1-31, page 4, lines 3-16 and 17-31, page 5, lines 3-21, figures 1-3). For example, according to one embodiment of Applicant's invention, to access a server 16 and/or one of network-based appliances 18-21, a user scans his/her fingerprint using a fingerprint scanner 26 coupled to the mobile controller 24 (at least at page 4, lines 3-6). The mobile controller 24 analyzes the fingerprint data to generate an IP address (at least at page 4, lines 6-16). Accordingly, for example,

independent Claim 1 recites a device comprising “a connection to a network” and a “network address derived from a user’s fingerprint.”

In the Final Office Action, the Examiner acknowledges that *Borgstrom* does not explicitly teach that a network address is derived from a user’s fingerprint (Final Office Action, page 2). However, the Examiner appears to assert that because *Borgstrom* purportedly teaches handwriting/signature recognition, such purported handwriting/signature recognition is a form of biometric processing and, therefore, it would have been obvious to modify the *Borgstrom* system to derive a network address from a fingerprint (Final Office Action, pages 2 and 3). Applicant respectfully disagrees.

Borgstrom appears to disclose a system for initiating functions on an electronic device by detecting a pattern on a specially formatted surface (e.g., an arrangement of dots, a particular symbol printed on the surface, or a specific pattern written with an electronic reading device) (*Borgstrom*, abstract, lines 1-6, column 3, line 66 to column 4, line 4). *Borgstrom* appears to disclose that, for example, an electronic pen can be used to fill in spaces on a form and the “markings [on the form] can then be converted into ASCII text using an appropriate handwriting recognition program” (*Borgstrom*, column 4, lines 36-46, figure 1)(emphasis added). *Borgstrom* also appears to disclose that the *Borgstrom* system can be used to send information to a uniform resource locator (URL) on the Internet or to access a web page (*Borgstrom*, column 5, lines 52-60, column 6, lines 57-67). For example, *Borgstrom* recites:

Another possible function is obtaining access to a web page by writing a complete or abbreviated URL in a web access area 240 and touching a “Connect” command area 242. For instance, writing “YAHOO” in the web access area 240 will cause a mobile phone or laptop in communication with the electronic pen 10 to automatically access the YAHOO! Web page.

(*Borgstrom*, column 6, lines 57-63). Thus, Applicant respectfully submits that the “handwriting/signature recognition” of *Borgstrom* as referred to by the Examiner appears to be nothing more than character recognition. Accordingly, Applicant

respectfully submits that such character recognition in *Borgstrom* is not “biometric processing” as asserted by the Examiner to the extent used in Applicant’s invention at least because any user would be able to use the *Borgstrom* system to access a URL; the *Borgstrom* system does not associate a particular writing on the formatted surface of *Borgstrom* with any particular user. In contrast, Applicant’s invention derives a network address based on “a user’s fingerprint” as recited by independent Claims 1 and 14 (emphasis added) and “from a fingerprint of a user” as recited by independent Claim 6 (emphasis added). Moreover, Applicant respectfully submits that biometric processing associated with a particular user addresses different problems and requires different algorithms than character recognition. Therefore, Applicant respectfully submits that *Borgstrom* does not disclose, teach or suggest deriving a network address based on any characteristic unique to a particular user. Accordingly for at least this reason, Applicant respectfully submits that *Borgstrom* does not disclose, teach or suggest Applicant’s invention as recited by independent Claims 1, 6 and 14.

Further, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness. For example, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine or modify reference teachings. *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 (Fed. Cir. 2000). Additionally, when the incentive to modify such reference teaching is not readily apparent, it is the duty of the examiner to explain why such modification is proper. *See Ex parte Skinner*, 2 USPQ 2d 1788, 1790 (B.P.A.I. 1987). In support of the Examiner’s obviousness rejection of Claims 1, 6 and 14, the Examiner states that it would be obvious to modify the *Borgstrom* reference because it “would improve processing” (Final Office Action, pages 2 and 3). Applicant respectfully submits that the Examiner’s basis for modifying the *Borgstrom* reference fails to rise to the level required to support a rejection under 35 U.S.C. § 103 at least because the asserted reasoning offers none of the required showings. For example, the Examiner does not identify any apparent disadvantage in the *Borgstrom* reference or specifically identify the particular “processing” of *Borgstrom* the Examiner considers to require “improv[ing].” Clearly, the Examiner is using Applicant’s disclosure as a blueprint for modifying the *Borgstrom* reference,

which is improper. Accordingly, Applicant submits that independent Claim 1 is patentable over the cited reference.

Independent 6 recites “a network address derived from a fingerprint of a user,” and independent Claim 14 recites “generating a network address derived from a user’s fingerprint.” At least for the reasons discussed above in connection with independent Claim 1, Applicant respectfully submits that independent Claims 6 and 14 are patentable over the cited reference.


Accordingly, for at least the reasons discussed above, independent Claims 1, 6 and 14, and Claims 2-5, 7-13 and 15-19 that depend respectively therefrom, are in condition for allowance.

CONCLUSION

Applicant has demonstrated that the present invention as claimed is clearly distinguishable over the art cited of record. Therefore, Applicant respectfully requests the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

The Commissioner is authorized to charge the statutory fee of \$500.00 to Deposit Account No. 08-2025 of Hewlett-Packard Company. Although no other fee is believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,


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Date: July 18, 2005

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CLAIMS APPENDIX

1. A device comprising:
connection to a network; and
network address derived from a user's fingerprint.
2. The device, as set forth in claim 1, wherein the network is the Internet and network address is an Internet address.
3. The device, as set forth in claim 1, further comprising a fingerprint scanner.
4. The device, as set forth in claim 1, further comprising a fingerprint file storing the fingerprint.
5. The device, as set forth in claim 1, further comprising a fingerprint file storing the network address derived from the fingerprint.
6. A system comprising:
a connection to a network; and
a network address derived from a fingerprint of a user.
7. The system, as set forth in claim 6, wherein the network address is derived from a fingerprint of an authorized user.
8. The system, as set forth in claim 6, wherein the network address is an Internet address.
9. The system, as set forth in claim 6, wherein the network address is an address of a global network.
10. The system, as set forth in claim 6, further comprising a fingerprint scanner.
11. The system, as set forth in claim 6, further comprising a memory storing a fingerprint file having the fingerprint.

12. The system, as set forth in claim 6, further comprising a fingerprint file storing the network address derived from the fingerprint.

13. The system, as set forth in claim 6, further comprising:
a server coupled to the Internet; and
at least one appliance coupled to the server.

14. A method, comprising:
generating a network address derived from a user's fingerprint; and
accessing a system over a network using the derived network address.

15. The method, as set forth in claim 14, further comprising obtaining a fingerprint.

16. The method, as set forth in claim 14, further comprising storing the fingerprint.

17. The method, as set forth in claim 14, further comprising generating an Internet address of the system derived from the fingerprint.

18. The method, as set forth in claim 14, wherein accessing the system comprises accessing a server coupled to the Internet using the generated network address, and accessing a plurality of appliances coupled to the server using network addresses based on the generated network address.

19. The method, as set forth in claim 14, further comprising generating system authorization based on the fingerprint.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None